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OFFICE OF PETITIONS

ON PETITION

In re REISSUE PATENT NO. RE37,894  
Issue Date: October 22, 2002  
Patent No. 5,494,297  
Issue Date: February 27, 1996  
Application No. 09/030,702  
Filed: February 25, 1998  
Attorney Docket No: SHAM02-00001

This is a decision on the "PETITION FOR RECONSIDERATION OF DECISION REFUSING TO ACCEPT DELAYED PAYMENT OF MAINTENANCE FEE 37 CFR § 1.378(e) filed March 11, 2008.

The petition under 37 CFR 1.378(e) is **DENIED**.<sup>1</sup>

**BACKGROUND**

The original patent issued February 27, 1996. The first maintenance fee due could have been paid during the period from March 1, 1999 through August 29, 1999 or with a surcharge during the period from August 30, 1999 through February 27, 2000. The second maintenance fee due could have been paid during the period from February 27, 2003 through August 26, 2003 or with a surcharge during the period from August 27, 2003 through February 27, 2004. This patent expired on February 27, 2000 for failure to timely remit the first maintenance fee.

In a petition filed September 5, 2007 under 37 CFR 1.378(b), petitioners asserted that the delay in payment of the first maintenance fee was unavoidable in that in spite of their reliance upon their attorney to maintain the patent, the attorney responsible for paying the first maintenance fee did not do so, the assignee was not aware of the non-payment of the maintenance fee and that they only learned that the maintenance fees had not been paid after notification from a third party in 2006.

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<sup>1</sup>This decision may be regarded as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Petitioners argued that Klehr, Harrison, Harvey, Branzburg and Ellers, LLP (Klehr Harrison) was retained by the assignee on or about August 13, 1997 to perform legal services related to intellectual property matters which included payment of the maintenance fees on Patent 5,494,297 and to file, prosecute, and eventually to pay maintenance fees on a reissue patent based on Patent 5,494,297 (i.e., Reissue Patent RE 37,894). In 2000, the Attorney at Klehr Harrison in charge of the petitioner's patent work, Scott Fields, left and joined the law firm of Obermeyer, Rebmann, Maxwell and Hippel, LLP (Obermeyer Rebmann) and on or about January 16, 2001, petitioner transferred the file for Reissue Application Serial No. 09/030,702 to Obermeyer Rebmann. While under the responsibility of Obermeyer Rebmann, Reissue Application Serial No. 09/030,702 issued into Reissue Patent RE 37,894 on October 22, 2002. In 2003, Scott Fields left Obermeyer Rebmann and joined the National IP Rights Center, LLP and petitioner transferred the files for Patent 5,494,297 and Reissue Patent RE 37,894 to the National IP Rights Center, LLP.

Petitioners argued that they were led to believe that Mr. Fields, the Klehr Harrison law firm, the Obermeyer Rebmann law firm and the National IP Rights Center law firm had all exhibited exemplary competence in ensuring that all filing deadlines related to Patent 5,494,297 and Reissue Patent RE 37,894 were timely met.

The only evidence provided to establish that the delay by the firms charged with payment of the maintenance fee was unavoidable was a statement of Peter Rogers, principal of Shamrock Lacrosse, Inc., the Assignee. The petition was dismissed in a decision mailed January 11, 2008 for failure to provide a sufficient showing that the delay in paying the maintenance fee was unavoidable. Petitioner was reminded that in the absence of an adequate showing of the diligence of his representatives in this matter throughout the period in question, the actions or inactions of the registered practitioners would remain imputed to the inventors.<sup>2</sup>

Specifically, the decision advised that it would be incumbent upon the petitioner to demonstrate, via a documented showing, that the entire delay was unavoidable which would include from the time the maintenance fee was due until the time petitioners became aware that the maintenance fee had not been paid, as well as from that point until the filing of the petition to reinstate. The decision further advised that any showing of unavoidable delay must include a statement from the principals responsible for payment of the maintenance fees as to why action was not taken to timely submit the required maintenance fee while the patent was under their control.

The instant petition under 37 CFR 1.378(e) provides additional explanation as to why petitioners believe the payment of the first and second maintenance fees were delayed and why that delay was unavoidable.

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<sup>2</sup>See In re Lonardo, 17 USPQ2d 1455 (Comm'r Pat. 1990).

### STATUTE AND REGULATION

35 USC 41(c)(1) states that:

The Director may accept the payment of any maintenance fee required by subsection (b) of this section after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

37 CFR 1.378(b)(3) states that any petition to accept delayed payment of a maintenance fee must include:

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee.

### OPINION

The Director may accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Director to have been "unavoidable". 35 USC 41(c)(1).

Acceptance of a late maintenance fee on the basis of unavoidable delay is considered under the same standard as that for reviving an abandoned application under 35 USC 133 because 35 USC 41(c)(1) uses the identical language, *i.e.*, "unavoidable" delay. Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995)(quoting In re Patent No. 4,409,763, 7 USPQ2d 1798, 1800 (Comm'r Pat. 1988)). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912)("The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner's request for reconsideration disagrees with the requirement that a documented showing that the entire delay was unavoidable must include a statement from the law firms that represented the Petitioner, as to why action was not taken to

timely submit the required maintenance fee while the patent was under their control. Petitioner's only support for this argument based on Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982) and MPEP §711.03(c), is that decisions for revival are to be made on a case by case basis and that the specific facts and circumstances of the present case favor reinstatement of Reissue Patent RE 37,894.

Further, on reconsideration, petitioner asserts that Attorney Scott Fields died in April 2007, that prior to his death they believed that he may have purposely concealed from the Petitioner the facts concerning the nonpayment of the Reissue Patent RE 37,894 maintenance fees in order to avoid a claim of legal malpractice. Therein Petitioner argues that it is fundamentally unfair to require the Petitioner to obtain a statement from Mr. Fields (now deceased) or his former law firms due to the potentially adverse relationship of those other parties to the Petitioner.

Petitioner is assured that the decision in this matter is based only on the facts and evidence provided and not on any other facts or circumstances, however, no additional evidence has been provided to substantiate a conclusion that the delay was unavoidable.

Petitioner's arguments and evidence have been reconsidered, but are not found to be sufficient to meet the burden of establishing unavoidable delay. To the contrary, Petitioner registers the following arguments though without any basis;

#### ARGUMENT 1.

The Assignee retained the Klehr Harrison law firm, the Obermeyer Rebmann law firm and the National IP Rights Center law firm, each of which employed Attorney Scott Fields and each of which was to perform legal services related to intellectual property matters which included payment of the maintenance fees on Patent 5,494,297 and to file, prosecute and eventually to pay maintenance fees on a reissue patent based on Patent 5,494,297 (i.e., Reissue Patent RE 37,894).

Petitioner has not provided any evidence however to show that an agreement existed between the Assignee and each of the law firms to perform legal services related to intellectual property matters which included payment of the maintenance fees on Patent 5,494,297 and to file, prosecute, and eventually to pay maintenance fees on a reissue patent based on Patent 5,494,297 (i.e., Reissue Patent RE 37,894). Neither has petitioner proffered any evidence to show what if any instructions were given to the various law firms with respect to the payment of the maintenance fees. In view thereof, with respect to the maintenance fees, petitioner has not provided any evidence to show that there were steps in place on the part of either the petitioner or the various law firms involved, to ensure that the maintenance fees were paid and the patents (Patent 5,494,297 and Reissue Patent RE 37,894) were maintained and in force.

ARGUMENT 2.

Attorney Scott Fields, the Klehr Harrison law firm, the Obermeyer Rebmann law firm and the National IP Rights Center law firm, each of which employed Attorney Scott Fields may have purposely concealed from the Petitioner the facts concerning the nonpayment of the Reissue Patent RE 37,894 maintenance fees in order to avoid a claim of legal malpractice. That therefore, Attorney Scott Fields, prior to his death, as well as the Klehr Harrison law firm, the Obermeyer Rebmann law firm and the National IP Rights Center law firm were unwilling to cooperate in the reinstatement of Reissue Patent RE 37,894 due to a potential malpractice claim against one or more of Mr. Fields, the Klehr Harrison law firm, the Obermeyer Rebmann law firm and the National IP Rights Center law firm.

Assuming the Klehr Harrison law firm, the Obermeyer Rebmann law firm and the National IP Rights Center law firm was responsible for payment of the maintenance fees, it has not been proven that there was not a conscious decision on the part of one or more of the firms not to pay the maintenance fees and thus, the claims that one or more of them purposely concealed from the Petitioner that the maintenance fee payments had not been made has not been substantiated. Likewise, the "potential" malpractice claims are at best purely conjecture.

As indicated in the case citations above, courts have adopted the "reasonably prudent person" standard in determining whether a delay was "unavoidable" within the meaning of the statute. After establishing in fact which of the firms was charged with the responsibility of paying the maintenance fees when due, to establish that the delay was unavoidable, petitioner would have to have shown that either the Klehr Harrison law firm, the Obermeyer Rebmann law firm and the National IP Rights Center law firm exercised that degree of care or diligence that "is generally used and observed by prudent and careful men in relation to their most important business." *In re Mattullath, supra* (emphasis added).

Without the principals from the Klehr Harrison law firm, the Obermeyer Rebmann law firm and/or the National IP Rights Center law firm with first hand knowledge of their diligence and the resulting delay, obviously petitioner will not be in a position to confirm whether or not they exercised diligence and that the delay in paying the maintenance fee was unavoidable.

As Petitioner argues reliance on the Klehr Harrison law firm, the Obermeyer Rebmann law firm and/or the National IP Rights Center law firm to have paid the maintenance fees when due, and assuming either or all of them were in fact responsible to do so, petitioner allegedly chose to rely upon one or all of them, such reliance *per se* does not provide petitioner with a showing of unavoidable delay within the meaning of 37 CFR

1.378(b) and 35 U.S.C. § 41(c).<sup>3</sup> Reliance upon the attorney merely shifts the focus of the inquiry from petitioner to whether the attorney or agent acted reasonably and prudently.<sup>4</sup>

Furthermore, assuming, *arguendo*, the Klehr Harrison law firm, the Obermeyer Rebmann law firm and/or the National IP Rights Center law firm had been employed by petitioner at the time the maintenance fee was due, petitioner is reminded that the United States Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the party, and petitioner is bound by the consequences of those actions or inactions.<sup>5</sup> Specifically, petitioner's delay caused by the mistakes or omissions of his voluntarily chosen representative(s) does not constitute unavoidable delay within the meaning of 35 USC 41(c) (1) and 37 CFR 1.378(b)(3).<sup>6</sup>

It should be noted that the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee. In fact, the record indicates that no steps were taken by patentee to ensure timely payment of the maintenance fee. Since no steps were taken by patentee, 37 CFR 1.378(b) precludes acceptance of the delayed payment of the maintenance fee.

It is further noted that 35 USC 41(c)(1) does not require an affirmative finding that the delay was unavoidable, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unavoidable. See Commissariat A. L 'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (DC. Cir 1960) (35 USC 133 does not require the Commissioner to affirmatively find that the delay was unavoidable, but only to explain why the applicant's petition was unavailing); see also In re Application of G, 11 USPQ 2d 1378, 1380 (Comm'r Pats 1989), (petition under 37 CFR 1.137(b) denied because the applicant failed to carry the burden of proof to establish that the delay was unintentional).

Upon review of the record, petitioner has not carried the burden of proof to show that the delay was unavoidable as required by statute and regulations of the Patent and Trademark Office. A petition to revive an application (or reinstate a patent) cannot be granted where petitioner has failed to meet his burden of establishing unavoidable delay, Haines v. Quigg, *supra*.

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<sup>3</sup>See California Med. Prod. v. Technol. Med. Prod., 921 F. Supp. 1219, 1259 (D. Del. 1995).

<sup>4</sup>Id.

<sup>5</sup>Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); Smith v. Diamond, 209 USPQ 1091, 1093 (D.D.C. 1981).

<sup>6</sup>Haines v. Quigg, *supra*; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); California, *supra*.

CONCLUSION

The requirements of 37 C.F.R. § 1.378(b)(3) have not been satisfied. The burden of establishing that the entire period of delay was unavoidable rests with Petitioner, and this showing has not been made. Consequently, the Office cannot accept the delayed payment of the 3½ and the 7½-year maintenance fees, and this petition cannot be granted.

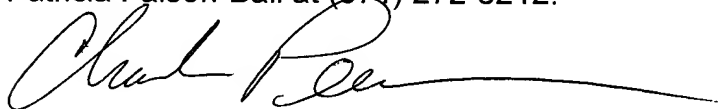
The prior decision which refused to accept under § 1.378(b) the delayed payment of a maintenance fee for the above-identified patent has been reconsidered. For the above stated reasons, however, the delay in this case cannot be regarded as unavoidable within the meaning of 35 USC 41(c)(1) and 37 CFR 1.378(b).

On petition filed September 5, 2007, fees in the amount of \$3000.00 were paid to cover the first and second maintenance fees as well as the surcharge for unavoidable delay. A review of the finance records reveals that a refund has been issued in the amount of \$2020. Since this patent will not be reinstated, the balance of the fees paid with the September 5, 2007, \$980.00, will be refunded in due course.

As stated in 37 CFR 1.378(e), no further reconsideration or review of this matter will be undertaken.

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Patricia Faison-Ball at (571) 272-3212.

A handwritten signature in black ink, appearing to read 'Charles Pearson', with a long horizontal flourish extending to the right.

Charles Pearson  
Director,  
Office of Petitions